

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	§	
Carlo Liberale et al.	§	Group Art Unit: 3753
	§	
Application No.: 10/586,205	§	Confirmation No.: 4778
	§	
Filed: July 13, 2006	§	Examiner: Schneider, Craig M.
	§	
For: ACTUATOR FOR THE	§	Atty. Docket: CMRN:0006/SWA/SIN
ACTUATION OF SUBMARINE	§	CCV/Dresser 030957 US
DEVICES	§	

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June 3, 2010 Date	/Tait R. Swanson/ Tait R. Swanson Reg. No. 48,226

RENEWED PETITION UNDER 37 C.F.R. § 1.181 TO WITHDRAW THE HOLDING OF ABANDONMENT

Applicants respectfully submit this Renewed Petition to withdraw the holding of abandonment in the above-referenced case. Applicants can establish that they did not receive the Office Action on which the USPTO based its decision to consider the above-referenced case abandoned. Therefore, Applicants respectfully request that the USPTO withdraw the holding of abandonment, in view of the holding articulated in *Delgar v. Schulyer*, 172 U.S.P.Q. 513 (D.D.C. 1971) and adopted by the USPTO in M.P.E.P. § 711.03(c).

Legal Requirements for Withdrawal of Holding of Abandonment

If the totality of an applicant's submitted evidence establishes that he did not receive the subject Office Action, then the USPTO should grant that applicant's petition to withdraw the holding of abandonment. The M.P.E.P. indicates that an un-received Office Action should not be the basis for a holding of abandonment. Under 35 U.S.C. § 133, an applicant must receive

“notice” of any action from the USPTO. As both the case law and the USPTO have concluded, this “notice” generally requires that the applicant must have actually received the Office Action. The M.P.E.P. § 711.03(c)(I)(A) states that:

Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment.

A rule of reason should be applied to determine if the applicant’s non-receipt is a function of mis-delivered mail or applicant’s own negligence.¹

The M.P.E.P. § 711.03(c) describes a list of evidentiary examples for reviewing abandonment withdrawal petitions, but further notes that other forms of evidence may be submitted:

If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

Again, Applicants’ petition should be reviewed in light of all of the submitted evidence, including items that are not expressly enumerated in § 711.03(c) but are in line with the logic underlying that section. In other words, M.P.E.P. § 711.03(c) merely provides examples rather than requirements, while indicating that a variety of evidence may be sufficient to establish non-receipt of the Office Action.

Facts Underlying Cameron’s Petition

On August 6, 2009, the USPTO mailed a Notice of Abandonment based on Applicants’ failure to timely file a proper reply to the Office Action mailed on October 31, 2008. On September 4, 2009, Applicants filed a petition requesting withdrawal of the holding of abandonment. Applicants submitted evidence directly from the USPTO’s PAIR system establishing that the USPTO mistakenly mailed the subject Office Action to Shell Oil Company,

not Applicants. In fact, the PAIR system indicates that Shell Oil Company mailed the subject Office Action back to the USPTO and indicated it had been sent to the wrong mailing address. On September 28, 2009, the Office of Petitions, nonetheless, dismissed the petition requesting withdrawal of the holding of abandonment. On January 26, 2010, Applicants filed a renewed petition requesting withdrawal of the holding of abandonment. On March 8, 2010, the Office of Petitions dismissed the renewed petition requesting withdrawal of the holding of abandonment.

Applicants' Renewed Petition

In accordance with 37 C.F.R. § 1.181 and M.P.E.P. § 711.03(c) I.A., Applicants hereby renew the petition to withdraw the holding of abandonment of the above-identified application based on a failure to receive the Office Action. In particular, Applicants hereby submit a Declaration (hereinafter “the Declaration”) of Manish Vyas in Support of Applicant’s Renewed Petition Under 37 C.F.R. § 1.181(a) to Withdraw the Holding of Abandonment, and its referenced Exhibits A, B, C, and D.

Manish Vyas is the Managing Attorney of Patent Services at Cameron International Corporation (hereinafter “Cameron”).² Mr. Vyas stated that Cameron has a reliable docketing system, which includes application numbers, attorney docket numbers, mailing dates of Office Actions, and due dates for Responses.³ In particular, each Office Action that is received at Cameron is docketed in Cameron’s docketing system.⁴ An individual docket sheet for each patent application and an attorney docket report may be generated from Cameron’s docketing system.⁵ Cameron received a mailing, at the correspondence address of record, of a Notice of Abandonment mailed on August 6, 2009, indicating abandonment due to Applicants’ failure to reply to an Office Action mailed on October 31, 2008.⁶ However, Cameron did not receive a mailing, at the correspondence address of record, of the Office Action mailed on October 31,

¹ Cf. § 711.03(c) (“[a showing] may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail”).

² Declaration of Manish Vyas, page 2, paragraph 3.

³ *Id.* at page 2, paragraph 4.

⁴ *Id.*

⁵ *Id.*

⁶ *Id.* at page 2, paragraph 5.

2008.⁷ A review of the Cameron docketing system and Mr. Vyas' records confirms that Cameron did not receive a mailing, at the correspondence address of record, of the Office Action mailed on October 31, 2008.⁸

A copy of the bibliographic data for the above-referenced application, as obtained from PAIR, is included as Exhibit A. As indicated in Exhibit A, the document description indicates "Mail returned to USPTO as undelivered" on a mailroom date of November 7, 2008.⁹ This clearly indicates that the Office Action mailed on October 31, 2008 was not successfully delivered to the mailing address to which the Office Action was sent. Rather, a copy of the returned Office Action is included as Exhibit B. As clearly indicated in Exhibit B, the Office Action was stamped by Shell Oil Company on November 3, 2008, and was subsequently stamped by the USPTO Mail Center on November 7, 2008.¹⁰ As such, the USPTO acknowledged that the Office Action mailed October 31, 2008 was being returned by Shell Oil Company, instead of Cameron. This clearly indicates that the Office Action mailed October 31, 2008 never reached Cameron, but instead was merely sent from the USPTO to and from Shell Oil Company. Despite this clear misdelivery to Shell and subsequent return to the USPTO, the USPTO did not make any further attempt to deliver the Office Action to Applicants. As a result, Applicants never received the Office Action, and were not provided with an opportunity to respond to the Office Action.

A copy of the individual docket sheet from Cameron's docketing system for the above-referenced application is included as Exhibit C. As indicated in Exhibit C, the Office Action was never received into the Cameron docketing system. More specifically, the individual docket sheet shows that there were no entries between the October 31, 2008 mailing date of the Office Action and the August 6, 2009 mailing date of the Notice of Abandonment.¹¹ In other words, there was no correspondence between the USPTO and Cameron logged into the Cameron docketing system between the mailing of the Office Action and the mailing date of the Notice of

⁷ *Id.* at page 2, paragraph 6.

⁸ *Id.*

⁹ *See also id.* at page 2, paragraph 7.

¹⁰ *See also id.* at page 3, paragraph 8.

¹¹ *See also id.* at page 3, paragraph 9.

Abandonment.¹² If the subject Office Action had been received by Cameron, it would have been listed in the individual docket sheet between the October 27, 2008 and August 6, 2009 entries.¹³ This is further evidence that the Office Action mailed October 31, 2008 was never received by Cameron.

A copy of the attorney docket report printed out on January 16, 2009 is included as Exhibit D. This report shows “all replies docketed for a date three months from the mail date of the non-received Office action.” See M.P.E.P. § 711.03(c)(I).¹⁴ As again indicated in Exhibit D, the Office Action was never received into the Cameron docketing system. More specifically, there are no action items at all shown for the above-referenced patent application (i.e., Docket Number 030957) on the due date of January 31, 2009 as of January 16, 2009.¹⁵ Again, if the subject Office Action had been received by Cameron, it would have been docketed and listed for January 31, 2009 in the attorney docket report of Exhibit D.¹⁶ This is further evidence that the Office Action mailed October 31, 2008 was never received by Cameron.

Conclusion

In view of the foregoing evidence, Applicants submit that the Office Action was clearly improperly delivered to Shell Oil Company rather than Cameron, the Office Action was returned to the Office, the Office recorded this Office Action as undeliverable, the Office did not attempt to re-mail the Office Action, and the Office subsequently mailed a Notice of Abandonment. Clearly, the evidence confirms that Applicants have not received a mailing of the Office Action mailed on October 31, 2008.

Accordingly, Applicants respectfully request that the Director grant the present petition to withdraw the holding of abandonment pursuant to 37 C.F.R. § 1.181 and M.P.E.P. § 711.03(c) I.A, and reinstate the application with its original filing date. Upon grant of this petition,

¹² *Id.*

¹³ *Id.*

¹⁴ See also *id.* at pages 3-4, paragraph 10.

¹⁵ *Id.*

¹⁶ *Id.*

Applicants further request re-mailing of the associated Office Action and re-starting of the time period for reply based on failure to receive the Office Action.

Authorization for Extensions of Time and Payment of Fees

In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request thereof. Specifically, in accordance with 37 C.F.R. § 1.136(a), Applicants request a one-month extension of time from May 8, 2010 to June 8, 2010. However, in accordance with M.P.E.P. § 711.03(c) I, Applicants submit that no other fees are currently due in association with this petition. The Commissioner is authorized to charge the requisite fee of \$130.00 for the one-month extension of time, and any additional fees which may be required to process this petition, to Deposit Account No. 03-0335; Order No. CCV/Dresser030957US (CMRN:0006/SWA).

Respectfully submitted,

Date: June 3, 2010

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